

REMARKS

Claims 1 through 20 are pending in this application. The Applicant appreciates the Examiner's indication of allowance concerning claims 5, 7 through 11 and 16 through 20.

I. CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 1, 3, 4, 12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Berner (US 5,267,178). The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

The Examiner stated that as to claims 1 and 12, Berner teaches an apparatus associated with a method comprising an input device (bar code reader BCR), a monitor (6), a computer (CPU 2), a driving device (CPU 20), a predetermined electric signal (figure 2, column 4, lines 47-52).

However, the monitor (6) in Berner, as seen in figure 2, as an optical display unit for displaying of messages and output is only for the user to see, while in the present invention, the display is being tested as there is an input of the display data channel of the monitor into the computer. As mentioned in col. 4, lines 46-47, the result is displayed on the display device 6 or request for entry of missing parts is transmitted to the display device 6 (col. 5, lines 27-31). Clearly the display data channel from the monitor is not being inputted into the computer as claimed in the present invention. As mentioned above in MPEP §2131, the identical invention must be shown in as complete detail as is contained in the patent claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989).

The Examiner further stated that as to claims 1 and 12, Berner discloses an apparatus associated with a method further comprising an interface section (SIF) indicating whether the display data channel of the monitor is inputted into the computer (2) and outputting a voltage signal reflective of an originally inputted voltage signal, the outputted voltage signal is switched at a different time according to a result of inputting the display data channel (column 4, lines 53-67).

However, the interface section (SIF) of Berner does not indicate whether the display data channel of the monitor is inputted into the computer. The SIF is connected to the bar code reader

BCR as seen in figure 2 of Berner. The SIF is basically a serial interface 7 connected by cable K to the bar code reader BCR. In col. 4, lines 53-67, only this connection is disclosed without any further clarification of the interface. Clearly, the SIF cannot *indicate* if the display data channel is inputted. Every element must be literally present, arranged as in the claim according to MPEP §2131, but the Examiner has failed to provide from Berner a disclosure that shows this element *as arranged in the claim*.

Moreover, as seen in col. 4, lines 53-67 of Berner (mentioned by the Examiner), Berner fails to disclose the outputting of a voltage signal reflective of an originally inputted voltage signal, the outputted voltage signal is switched at a different time according to a result of inputting the display data channel. Col. 4, lines 53-67, mentioned by the Examiner, states the following:

If the computer receives the message, the reader is connected, otherwise it is not. If no bar code reader BCR is connected, the computer 2 is deactivated (box 105), followed by a waiting period of for example 30 seconds (box 106), after which the display 6 is also turned off (box 107) and the instrument returned to the initial stand-by state. With the exception of the testing of the bar code reader (boxes 103 and 104), the process is the same as with the known spectrophotometer SPM 100 of Gretag AG.

If the computer 2 recognizes a connected bar code reader BCR (box 104), initially a time window of for example 30 seconds is opened, during which the computer 2 and the power supply connection PIF remain activated (box 110).

Clearly, in this section mentioned by the Examiner, nor in any other section of Berner, there is no disclosure of the output signal being reflective of the original voltage signal and there is no disclosure of the outputted voltage being switched at a different time. Berner is only disclosing of if the bar code reader is connected or not, which is clearly different from what the invention is claiming. If the BCR (bar code reader) is not connected, in Berner, then the display is turned off.

However, the present invention claims is concerning the result of the inputting of the display data channel and not just if the bar code reader being connected or not.

Concerning claims 1 and 12, the Examiner further stated that Berner discloses a controller (CPU 2) for controlling, analyzing, and determining whether or not the result of inputting the display data channel is correct (figures 2 and 3, column 5, lines 15-46).

However, again as before, figures 2 and 3 and col. 5, lines 15-46 fail to mention the display data channel and so there is not determination of whether or not the result of the inputting the display data channel is correct. Berner only mentions about checking data read by the bar code reader being tested for errors which still fails to discuss the display data channel. As mentioned above, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Therefore, the display data channel must be considered.

As to claims 4 and 15, the Examiner stated that Berner teaches the controller for the controlling and determining including a programmable logic controller (EPROM, column 1, lines 52-56).

However, the EPROM in col. 1, lines 52-56 is referring to an external storage for information inputted. An EPROM stands for an erasable type programmable read-only-memory which is not a PLC (programmable logic controller).

Moreover, in claims 4 and 15, it states that the controller includes a PLC but the Examiner

has already stated that the controller is the CPU of Berner which is a distinct element from the EPROM.

II. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 2, 6 and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Berner in view of Keiji (previously cited). The Applicant respectfully traverses.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20

USPQ2d 1438 (Fed. Cir. 1991).

The Examiner stated the following:

As to claims 2 and 13, Berner teaches all of the claimed limitations of claims 1, 12, except for the inputting device includes a mouse. However, Keiji teaches a related input device including a mouse (figure 5, column 4, lines 22-29). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the mouse taught by Keiji for Berner's input device because this would provide the operator with visual feedback to verify the mouse and thereby saving time and money on mistake scanning.

As to claim 6, Keiji teaches a switch (43) to select one of the mouse (48) and the scanner (49) (figure 5).

As shown above in the discussion of 35USC§102 concerning Berner not disclosing all of the claimed elements, Berner also does not teach or suggest all of the limitation of the present invention and therefore, the combination does not teach or suggest all of the limitations under 35USC§103.


Concerning claims 2, 6 and 13, the Examiner mentions a motivation to combine Kiji and Berner as "It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the mouse taught by Keiji for Berner's input device because this would provide the operator with visual feedback to verify the mouse and thereby saving time and money on mistake scanning." However, as claimed by the present invention, the inputting device includes a mouse which inputs the display data channel into the computer. As mentioned in MPEP §706.02(j), "The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." Therefore, it is not clear that the motivation to combine is from the prior art or actually taken from the present invention.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Response. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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